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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPICANT	ATTY. DOCKET NO.
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08/855,402 05/13/97 BRADFIELD

C.

EXAMINER

DRESSLER ROCKEY  
MILNAMOW & KATZ LTD.  
TWO PRUDENTIAL PLAZA SUITE 4700  
180 NORTH STETSON AVENUE  
CHICAGO IL 60601

HM22/0908

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

09/08/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 08/07/99
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1, 2, 4-6, 8-12, 14-20 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 2, 4-6, 8-12, 14-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

Art Unit: 1646

1) The request filed on 03 August of 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/855,402 is acceptable and a CPA has been established. An action on the CPA follows.

2) Claims 1, 2, 4 to 6, 8 to 12 and 14 to 20 are pending in the instant application.

3) Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

4) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5) The oath or declaration is defective for those reasons of record in section 2 of Paper Number 5 and section 4 of Paper Number 8.

6) Claims 1, 2, 4 to 6 and 8 to 20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 17 of U.S. Patent No. 5,650,283 for those reasons of record in section 3 of Paper Number 5 and section 5 of Paper Number 8.

7) Claims 1, 2, 4 to 6, 8 to 12 and 14 to 20 stand rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to an Ah receptor protein having that amino acid sequence presented in either SEQ ID NO:2 or 4 of the instant specification for those reasons of record in section 4 of Paper Number 5 and section 6 of Paper Number 8.

8) Claims 1, 2, 4, 15, 16 and 18 to 20 are rejected under 35 U.S.C. § 103 as being unpatentable over the Ema et al. publication (BIOCHEM. BIOPHYS. RES. COMM. 184(1):246-

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253, 15 Apr. 1992) in view of the combination of the Mak et al. (J. Biol. Chem. 264(36):21613-21618, 25 Dec. 1989) and Hoffman et al. (SCIENCE 252:954-958, 17 May 1991) publications for those reasons of record in section 6 of Paper Number 5 and section 8 of Paper Number 8.

9) This is a CPA of applicant's earlier Application No. 08/855,402. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee can be reached at (703) 308-2731.

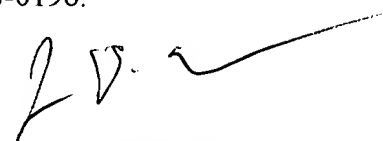
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Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**JOHN ULM  
PRIMARY EXAMINER  
GROUP 1800**